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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/579,594	05/17/2006	Antonio Buxade Vinas	CUR10326P00010US	3552
32116 7590 07/30/2009 WOOD, PHILLIPS, KATZ, CLARK & MORTIMER 500 W. MADISON STREET SUITE 3800 CHICAGO, IL 60661			EXAMINER OH, TAYLOR V	
			ART UNIT 1625	PAPER NUMBER
			MAIL DATE 07/30/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/579,594	Applicant(s) VINAS ET AL.	
	Examiner Taylor Victor Oh	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 3,7 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6,8-17 and 19-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/06 & 5/06</u> . | 6) <input type="checkbox"/> Other: _____ |

The Status of Claims:

Claims 1-23 are pending.

Claims 1-2,4-6,9-17,19-23 are rejected.

Claims 3,7,18 are withdrawn from consideration .

DETAILED ACTION

1. Claims 1-2,4-6,8-17,19-23 are under consideration in this Office Action.

Priority

2. It is noted that this application is a 371 of PCT/JP02/12409 (11/28/02), which has foreign priority documents, Japan 2001-363336 (11/28/2001) and Japan 2002-248888 (08/28/2002).

Drawings

3. None.

Election/Restriction

Applicant's election with traverse of Group II (claims 1-2,4-6,9-17,19-23) on 5/22/09 is acknowledged.

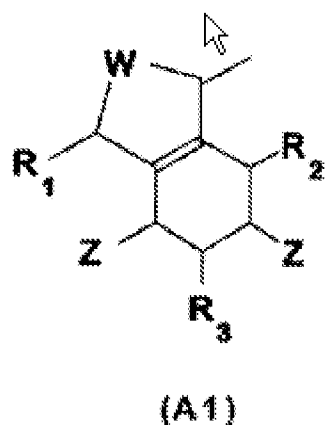
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Claims 3,7,18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected groups I and III-IV, there being no allowable generic or linking claim. New claim 23 is added and belonged to Group II.

Claim Objections

Claims 1, 8,17, are objected to because of the following informalities:

In claim 1 , the chemical formula(A1) and



the phrase “

- W represents a dienophile selected from SO₂ and a diacylazo group such as 4-phenyl-1,2,4-triazolin-3,5-dione or phthalazin-1,4-dione; and” are recited .

These limitations are belonged to the other groups I, and III-IV. Therefore, those need to be removed from the claims.

In claim 8, the chemical formulas , (IA1b) and (IA1c) are recited These limitations are belonged to the other groups I,III-IV. Therefore, those need to be removed from the claims.

In claim 17, the following limitations are recited:

- when moiety A in the starting aldehyde (VI) corresponds to general formula (A1) and the compound of formula (I) is wished to be obtained in which A is the moiety of general formula (A2), the product obtained from the reaction of the aldehyde with the haloform in the presence of a Cr²⁺ complex or salt is reacted with a base,
- when moiety A in the starting aldehyde (VI) corresponds to general formula (A1) and the compound of formula (I) is wished to be obtained in which A is the moiety of general formula (A3), the product obtained from the reaction of the aldehyde with the haloform in the presence of a Cr²⁺ complex or salt is first reacted with a base and then subjected to UV or VIS light irradiation until obtaining the 5(Z) configuration, and

These limitations are belonged to the other groups I,III-IV. Therefore, those need to be removed from the claims.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-2,4-6,8-17,19-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1,9,17,19,20-23, the term "general " is recited. This expression is vague and indefinite because the specification does not elaborate what is meant by the term "general ." Appropriate correction is required.

In claim 1, the phrase " a hydroxyl protective group" is recited. This expression is vague and indefinite because the claims do not specify what they are except where they can be found.

Appropriate correction is required.

In claim 9, the phrase "if so desired, converting the compound of formula(I) into another desired compound of formula(I) " is recited. This expression is vague and indefinite because the claims do not specify when it is so desired to convert necessary to convert the compound of formula(I) into another desired compound of formula(I) and how it is converted from the compound of formula(I) into another desired compound of formula(I); how they are different from each other with respect to their chemical structure.

Appropriate correction is required.

In claim 19, the phrase "photosensitizers derived from anthracene, acridine or phenazien and ultraviolet light " is recited. This expression is vague and indefinite

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because the claims do not specify how photosensitizers are derived from anthracene, acridine or phenazine and ultraviolet light. Appropriate correction is required.

Claim 22 provides for the use of a compound of general formula (IV), but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 22 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Taylor Victor Oh/
Primary Examiner, Art Unit 1625

7/29/09